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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,270	10/16/2003	John Gavin MacDonald	18,971	9987
23556	7590	09/17/2004	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. 401 NORTH LAKE STREET NEENAH, WI 54956			NASSER, ROBERT L	
			ART UNIT	PAPER NUMBER

3736

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/687,270	<b>Applicant(s)</b> MACDONALD ET AL.	
	<b>Examiner</b> Robert L. Nasser	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7-11, 16, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodriguez-Fernandez et al 2001/0056246. Rodriguez-Fernandez shows a breath testing device with a visual indicating agent 4 that is sensitive to at least one odor in the breath and changes color in response to the odor. With respect to claim 2, element 4 is sensitive to hydrogen sulfide, which is a sulfur containing compound. With respect to claims 7 and 8, that the claim is a product by process claim. As such, the prior art need only provide teach the identical structure, regardless of how it was made (See MPEP 2113). With respect to claims 7 and 8, Rodriguez-Fernandez teaches the identical structure, i.e. a color change indicator dried onto a substrate. Hence, it anticipates the claim. With respect to claim 9, the substrate is a silica gel, which is a synthetic polymer. With respect to claims 10 and 11, the substrate is at an end of tube 1. Claims 16 and 17 are rejected for the reasons given above. With respect to claim 19, Rodriguez-Fernandez teaches the claim method

Claims 1-3, 7-9, 12, 14, 15, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Berry 3507269. Berry shows a device for indicating bad breath that has several color change elements, one being sensitive to sulfur containing compounds (see column 2, lines 55-56) and one to amine containing

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compounds (see column 3, line 38). With respect to claims 7 and 8, that the claim is a product by process claim. As such, the prior art need only provide teach the identical structure, regardless of how it was made (See MPEP 2113). With respect to claims 7 and 8, Rodriquez-Fernandez teaches the identical structure, i.e. a color change indicator dried onto a substrate (see column 2, lines 40-42 and column 3, lines 15-25). . Hence, it anticipates the claim. With respect to claim 9, the substrate is filter paper (see column 2, lines 32-33) which is cellulose. With respect to claim 12, the indicator stays in solution (see column 3, line 33-36). With respect to claims 14 and 15, Berry teaches using a suitable color chart to identify the degree of color change (see column 3, lines 65-68). With respect to claim 19, Berry teaches the method.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriquez-Fernandez et al in view of Hoshino 3615478. Hoshino further teaches the michler's hydrol undergoes a color change in response to sulfur containing substances (see abstract and column 4, line 32 in combination). Hence, it would have been obvious to modify Rodriquez-Fernandez to use michler's hydrol, as it is merely the substitution of one known color indicator for another.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry et al in view of Hoshino 3615478. Hoshino further teaches the michler's hydrol undergoes a color change in response to sulfur containing substances (see abstract and column 4, line 32 in combination). Hence, it would have been obvious to modify Berry to use michler's hydrol, as it is merely the substitution of one known color indicator for another.

Claim 6 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez-Fernandez et al in view of Hoshino, as applied to claims 4 and 5 above, further in view of Macdonald 2003/0203009. Macdonald further teaches a color change indicator made from nanoparticles. From this teaching, it would have been obvious to modify the above combination to use such a color change material, as it is merely the substitution of one known indicator for another.

Claim 6 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Hoshino, as applied to claims 4 and 5 above, further in view of Macdonald 2003/0203009. Macdonald further teaches a color change indicator made from nanoparticles. From this teaching, it would have been obvious to modify the above combination to use such a color change material, as it is merely the substitution of one known indicator for another.

The applied reference to Macdonald has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim 6 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriquez-Fernandez et al in view of Hoshino, as applied to claims 4 and 5 above, further in view of Cha et al 2003/008237. Cha further teaches a color change indicator made from nanoparticles (see paragraph 80). From this teaching, it would have been obvious to modify the above combination to use such a color change material, as it is merely the substitution of one known indicator for another.

Claim 6 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Hoshino, as applied to claims 4 and 5 above, further in view of Cha et al 2003/008237. Cha further teaches a color change indicator made from nanoparticles (see paragraph 80). From this teaching, it would have been obvious to modify the above combination to use such a color change material, as it is merely the substitution of one known indicator for another.

Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rodriquez-Fernandez et al. The 102 rejection was addressed above. Alternatively, it would have been obvious to make the device in the manner recited in claim 8, as all methods of making the device appear to function equally as well as the other.

Claims 12, 13, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriquez-Fernandez et al. With respect to claims 12 and 13, applicant has not stated that the form of the indicator solves a stated problem or

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that it is for a particular purpose. As such, the exact form of the indicator would have been a mere matter of design choice for one skilled in the art, as all forms of the indicator appear to function equally as well. With respect to claim 18, applicant has not stated that the shape of the carrier solves a stated problem or that it is for a particular purpose. As such, the exact shape of the carrier would have been a mere matter of design choice for one skilled in the art, as all shapes of the carrier appear to function equally as well. With respect to claim 20, it would have been obvious to provide the device in a dispenser for dispensing the device.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry. With respect to claim 13, applicant has not stated that the form of the indicator solves a stated problem or that it is for a particular purpose. As such, the exact form of the indicator would have been a mere matter of design choice for one skilled in the art, as all forms of the indicator appear to function equally as well.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez-Fernandez et al in view of Berry 3507269. Berry teaches using a suitable color chart to identify the degree of color change (see column 3, lines 65-68). Such an arrangement enables an easier determination of the degree of color change. Hence, it would have been obvious to modify Rodriguez-Fernandez to use such a color chart, to simplify the determination of color change.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez-Fernandez et al in view of Pedersen 6607711 and Withers et al 5,245,117. Pedersen teaches in the background paragraphs 64 and 70 and in the description at paragraph 89, for example, teach using a halimeter (bad breath tester) to determine the effects of a breath freshener. Therefore, it would have been obvious to modify Rodriguez-Fernandez to use its device to test how well a freshener works, as it is merely the use of the device for a known method. The combination does not have a dispenser, e.g. container, containing the testing device and the breath freshener. Withers et al teaches a diabetes kit which includes both a glucose testing device and an insulin supply. As such, it has a testing means and a treating means in the same device to provide ease of treatment for the user. The Federal Circuit has established that a reference is good for all it teaches. When applied here, Withers teaches modifying the above combination to use a single container, to simplify the treatment process.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakamura, Diamond, and Rosenberg et al all show halitosis testing devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (703) 308-3251. The examiner can normally be reached on Mon-Fri, variable hours.



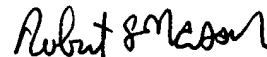
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser  
Primary Examiner  
Art Unit 3736

RLN  
September 15, 2004



ROBERT L. NASSER  
PRIMARY EXAMINER